Supreme Court, U.S.
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No. 03-773

In The
Supreme Court of the United States

FESTO CORPORATION,

Petitioner,

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD., a/k/a SMC CORPORATION and SMC PNEUMATICS, INC.,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

CHARLES R. HOFFMANN
Counsel of Record
GLENN T. HENNEBERGER
ANTHONY E. BENNETT
HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(516) 822-3550

Counsel for Petitioner Festo Corporation

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QUESTIONS PRESENTED

The doctrine of equivalents prevents a copyist from avoiding patent infringement by making unimportant and insubstantial changes to a patented invention. This doctrine is limited by prosecution history estoppel, which prevents patent holders from reclaiming subject matter surrendered during prosecution of a patent. This Court in *Festo v. Shoketso Kinzoku Kogyo Kabushiki Co.* (App. 44a-60a) addressed the scope of prosecution history estoppel as a limitation to the doctrine of equivalents. In *Festo*, this Court unanimously rejected the complete bar to equivalents established by the Court of Appeals for the Federal Circuit. Recognizing that amendments to a claim do not always surrender equivalents, this Court established a rebuttable presumption in an effort to strike a balance between the right of inventors to establish infringement under the doctrine of equivalents and the notice function of patents. Upon remand, the Federal Circuit has severely undercut the avenues of rebuttal created by this Court in direct conflict with the spirit of that decision. The Federal Circuit is on a clear path to return to the complete bar.

The questions presented, therefore, are:

1) Whether the Federal Circuit's *en banc* decision impermissibly limits a patentee's right to overcome the *Festo* presumption, thereby effectively reinstating the complete bar in direct conflict with this Court's precedent.

2) Whether the Federal Circuit's interpretation of the *Festo* presumption and limitations to the available evidence to overcome the rebuttable presumption violates the Due Process Clause of the Fifth Amendment to the United States Constitution.

PARTIES TO THE PROCEEDING

Pursuant to S. Ct. Rule 29.6, Petitioner, Festo Corporation, states that its parent corporation is Festo AG.

There are no subsidiaries or affiliates of Festo Corporation or Festo AG that have issued shares to the public.

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Festo Corporation hereby petitions for a writ of *certiorari* to review the *en banc* judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The Federal Circuit's *en banc* decision on remand and denial of a petition for rehearing *en banc* (App 1a-43a, 282a-283a) is reported at 344 F.3d 1359. Prior opinions include this Court's decision vacating the Federal Circuit *en banc* decision and remanding the case (App. 44a-60a) which is reported at 535 U.S. 722. The Federal Circuit's *en banc* decision entering judgment on rehearing in favor of respondents (collectively referred to as "SMC") (App. 61a-223a) is reported at 234 F.3d 558. The Federal Circuit's opinion affirming the district court's judgment of infringement in favor of petitioner (App. 258a-276a), is reported at 72 F.3d 857. This Court's order granting *certiorari*, vacating and remanding for further consideration in view of *Warner-Jenkinson* is reported at 520 U.S. 1111. The Federal Circuit's decision after remand from this Court reinstating the judgment in favor of petitioner (App. 224a-257a) is reported at 172 F.3d 1361. The judgment of the United Stated District Court, Massachusetts is unreported and reprinted in the Appendix at pp. 277-281.

JURISDICTION

The Federal Circuit *en banc* entered its opinion and order on September 26, 2003. (App. 1a). A Petition for Rehearing *En Banc* was denied on November 5, 2003. (App. 282a-283a). This Court has jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article 1, section 8, clause 8 of the Constitution provides:

> Congress shall have the power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Fifth Amendment to the Constitution provides in pertinent part:

> No person shall * * * be deprived of life, liberty, or property, without due process of law * * *.

35 U.S.C. § 271(a) provides:

> Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

The Federal Rule of Evidence 402 provides:

> All relevant evidence is admissible, except as otherwise provided by the Constitution of the United States, by Act of Congress, by these rules, or by other rules prescribed by the Supreme Court pursuant to statutory authority. Evidence which is not relevant is not admissible.

STATEMENT OF THE CASE

The present case represents a significant departure from this Court's precedent on the issue of the doctrine of equivalents. Under this well established doctrine, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997). Without the protection of the

doctrine of equivalents, patent-holders would be at the mercy of copyists who could appropriate to their use the essence of an invention by simply introducing a minor and insubstantial variation from the literal terms of just one of the elements described in the patent. Limits to the doctrine of equivalents have included prosecution history estoppel, which prevents a patent holder from asserting as equivalent subject matter that was surrendered during prosecution.

This Court, throughout the years, has repeatedly repelled attacks on the doctrine seeking to eliminate access to the equitable doctrine. (App 44a-60a), *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950), *Warner-Jenkinson*, 520 U.S. at 21. In a prior stage of this case, a recent attack against the doctrine was advanced by the Federal Circuit, which erected a complete bar to the doctrine of equivalents for amended claim elements. (App. 84a). Contrary to this Court's decisions, including a decision in a prior review of this case, the Federal Circuit remains steady in its attempt to vanquish the doctrine from the legal landscape in a manner that violates this Court's precedent and a patentee holder's due process.

Petitioner Festo Corporation is the owner of two U.S. patents found to be infringed by Respondent ("SMC") after a jury trial and a summary judgment motion in the district court. Some of the accused devices were found to have literally infringed the claims of Petitioner's patents, while other slightly modified units were found to infringe under the doctrine of equivalents. Respondent then appealed the findings of infringement under the doctrine of equivalents. On two occasions, a unanimous panel of the Federal Circuit affirmed. (App.224a-257a, 258a-276a). After rehearing *en banc*, however, the Federal Circuit severely restricted the doctrine by holding that amending a claim element creates a "complete bar" to *any* range of equivalents thus permitting near-identical copying of the patented product. The

complete bar was rejected by this Court and a rebuttable presumption was created. This Court set forth specific bases under which a patent holder could present evidence to rebut the presumption and establish that the accused equivalent was not surrendered by the claim amendment. (App. 58a-59a). Upon remand from this Court, the Federal Circuit created new and rigid limitations on the scope of rebuttal evidence severely restricting a patent holder's right to overcome the presumption.

Since most patent claims are amended in the application process, including the vast majority of the 1.2 million patents now in force, the *en banc* majority has disrupted the balance in favor of copyists and severely undercut the protection provided by patents already issued and those to be issued in the future.

1. *Prosecution History of Festo's Patents.* The Stoll and Carroll patents are directed to linear actuators known as "magnetically coupled rodless cylinders." Briefly stated, these devices are employed in a wide range of industrial applications to transport articles from one point to another. The actuators include three basic components: a piston, a cylinder tube, and a sleeve. The piston sits inside the cylinder and is driven by pressurized fluid. The sleeve surrounds a portion of the cylinder tube and is magnetically coupled to the piston. Accordingly, reciprocal movement of the piston within the cylinder tube causes the sleeve to move along the cylinder tube without the need for any mechanical linkage between the piston and sleeve. This allows the device to move articles or machinery as desired. (App. 92a).

The U.S. Patent and Trademark Office ("PTO") initially rejected the pending claims in the Stoll patent application under 35 U.S.C. § 112 ¶ 1, which requires that the patent contain "a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person

skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . ." The patent examiner concluded that the "exact method of operation [was] unclear" because he was unsure whether the device operated as "a true motor or magnetic clutch." (App. 35a). The examiner also objected to the claims under ¶ 2 of 35 U.S.C. § 112 because some were improperly multiply dependent. *Id.* Dr. Stoll submitted a new independent claim and amended several dependent claims in order to *clarify* the nature of the device. (App. 35a-36a, 253a).[1] The claims were never rejected in view of prior art.

The relevant amendments to the Carroll patent occurred after Festo voluntarily submitted that patent for re-examination in view of a German prior art reference that had not been considered during the original prosecution. During that proceeding, Carroll amended the claim without prompting from the examiner.[2]

The SMC devices that were found to infringe the Stoll and Carroll patents under the doctrine of equivalents are identical to the claimed inventions save in two insubstantial respects.[3]

---

[1] Specifically, Dr. Stoll included within his broadest claim (independent claim 1) two limitations relevant here: (i) that there be two sealing rings disposed on the piston and (ii) that the outer sleeve of the device be made from magnetizable material. Both limitations had originally appeared in dependent claims when the application was first filed. (App. 37a, 253a).

[2] The claim was amended to include, among other things, two sealing rings, but Festo argued that what distinguished the amended claims was that the prior art did not "teach or render obvious the claimed combination which includes the plurality of magnets, end members, and cushion members in the claimed relationship." (App. 240a-241a).

[3] *First*, rather than having a one-way sealing ring on each end of the piston, the SMC devices have a single two-way sealing ring located at one end of the piston. *Second*, the sleeve of the SMC device is made of an aluminum alloy. *See* (App. 46a).

2. *The Proceedings Below.* Festo sued SMC for infringing the Stoll and Carroll patents. The United States District Court for the District of Massachusetts granted summary judgment in favor of Festo, concluding that SMC's rodless cylinders infringed the Carroll patent under the doctrine of equivalents. Thereafter, a jury found that SMC infringed the Stoll patent under the doctrine of equivalents. (App. 91a).

On SMC's appeal, a Federal Circuit panel affirmed in full. (App. 258a-276a). After denial of rehearing, SMC petitioned for *certiorari*. This Court granted *certiorari*, vacated the judgment and remanded the case for further consideration in light of its then-recent decision in *Warner-Jenkinson*, in which the Court unanimously reaffirmed the vitality of the doctrine of equivalents.

Upon remand in *Warner-Jenkinson*'s wake, another Federal Circuit panel reinstated the prior findings that SMC's devices contained no differences of substance from the patented inventions. With respect to the Stoll patent, the panel held that one amendment was likewise voluntary, not made to avoid the prior art, and thus prosecution history estoppel did not apply. (App. 256a). Because the other amendment in this patent presented an "unresolved issue," the Federal Circuit panel remanded to the district court to determine, *ab initio*, whether the *Warner-Jenkinson* presumption should apply and if so, whether it could be rebutted. (App. 256a-257a).

3. *The En Banc Decision:* The Federal Circuit reheard the case *en banc* and, in a sharply divided 8 to 4 decision, reversed the finding of infringement under the doctrine of equivalents as to both patents. (App. 61a-223a). The *en banc* majority concluded that prosecution history estoppel acts as a "complete bar" to application of the doctrine of equivalents to an amended element. (App. 64a, 73a-90a). Based on this ruling, the majority reversed the district court's finding of infringement solely on the basis of estoppel. *Id.*

Left intact, as the law of this case, were the findings that SMC's devices embodied no substantial differences from Festo's patented inventions.

4. *This Court's Festo Decision*: In a unanimous decision, this Court rejected the complete bar imposed by the Federal Circuit. "The Court of Appeals ignored the guidance of *Warner-Jenkinson,* which instructed that courts must be cautious before adopting changes that disrupt the settled expectations of the inventing community." (App. 57a). This Court acknowledged that:

> patent prosecution occurs in the light of our case law. Inventors who amend their claims under the previous regime had no reason to believe they were conceding all equivalents. If they had known they might have appealed the rejection instead. There is no justification for applying a new and more robust estoppel to those who relied on prior doctrine.

Id.

This Court also recognized that:

> [prosecution history estoppel's] reach requires an examination of the subject matter surrendered by the narrowing amendment. The complete bar avoids this inquiry by establishing a *per se* rule; but that approach is inconsistent with the purpose of applying the estoppel in the first place--to hold the inventor to the representations made during the application process and to the inferences that may reasonably be drawn from the amendment.

(App. 55a-56a).

> This Court stated,
> [t]here is no reason why a narrowing amendment should be deemed to relinquish equivalents unforeseeable at the time of the amendment and

> beyond a fair interpretation of what was surrendered. Nor is there any call to foreclose claims of equivalence for aspects of the invention that have only a peripheral relation to the reason the amendment was submitted.

(App. 56a).

This Court further noted that "[t]his presumption is not, then, just the complete bar by another name." (App. 59a).

The Federal Circuit decision was vacated and remanded to the Federal Circuit for further proceedings consistent with the Supreme Court decision to determine in the "first instance" the new issues raised. (App. 60a).

5. *The En Banc Decision on Remand*: The Federal Circuit issued an *en banc* order requesting briefing by the parties on the following four issues:

> 1. Whether rebuttal of the presumption of surrender, including issues of foreseeability, tangentialness, or reasonable expectations of those skilled in the art, is a question of law or one of fact; and what role a jury should play in determining whether a patent owner can rebut the presumption.
>
> 2. What factors are encompassed by the criteria set forth by the Supreme Court.
>
> 3. If a rebuttal determination requires factual findings, then whether, in this case, remand to the district court is necessary to determine whether Festo can rebut the presumption that any narrowing amendment surrendered the equivalent now asserted, or whether the record as it now stands is sufficient to make those determinations.
>
> 4. If remand to the district court is not necessary, then whether Festo can rebut the presumption that

> any narrowing amendment surrendered the equivalent now asserted.

(App. 5a-6a).

In the decision on remand, the Federal Circuit held that whether a patentee can overcome the presumption is entirely a matter of law. Therefore, it was only for the judge to determine whether the *Festo* presumption was rebutted. (App. 9a-10a). In addressing question 2, the court limited the evidence which could be introduced to overcome the presumption. Specifically, as to the tangentialness criterion, the court restricted the evidence to that found in the prosecution history. (App. 13a). The court also determined that the "some other reason" criterion was "vague" and had to be a narrow one, and that any rebuttal evidence should be limited to the file history. (App. 13a-14a). As to issues 3 and 4, on the prosecution record and the trial record, both developed well before the *Festo* presumption was created and having no evidence directly addressing the newly created presumption, the Federal Circuit *sua sponte* decided that Festo could not establish that the reason for the amendment was tangential, or that there was some other reason to support a showing that there was no surrender. (App. 16a-17a, 19a-20a). The case was remanded to the district court with only the issue of foreseeability to be determined by the district court judge. (App. 21a).

Circuit Judge Newman, joined by Chief Circuit Judge Mayer, dissented in part based on the majority's refusal to give Festo a full and fair hearing in the district court to rebut the newly created *Festo* presumption.

> The Court remanded, to this court and the district court, for application of these principles to Festo's Carroll and Stoll patents, and specifically for determination of "what territory the amendments surrendered" and "whether petitioner can demonstrate that the narrowing amendments did not

> surrender the particular equivalents at issue." *Festo*, 535 U.S. at 741. My colleagues now implement the presumption of surrender in ways that enlarge the surrendered territory, and implement the rebuttal analysis by converting two of the Court's three rebuttal criteria into questions of law and then deciding them, sua sponte, without trial or record. My colleagues deny Festo's request to present evidence as to these issues despite their status as questions of first impression.

(App. 29a-30a).

Newman's dissent further stated, "I do not agree with the treatment of the factual criteria of 'tangentialness' and 'other reasons' as questions of law, or with the adjudication of these new issues without permitting evidence and argument in accordance with the procedures of trial." (App. 30a). The dissent went on to further protest the majority's denial of Festo's procedural right to a trial and appeal:

> The patentee must establish that although the entire intervening territory was presumptively surrendered, the particular alleged equivalent was not surrendered. Festo states that it can meet the Court's rebuttal criteria, and has proffered evidence as to all three criteria. This court now denies Festo the opportunity to present evidence as to the two criteria of tangentialness and some other reason, establishing these criteria as questions of law, not fact, and decides these questions of first impression without development and without evidence. As to these criteria, Festo has been deprived of both trial and appeal.

(App. 38a-39a).

The dissent expressed further concerns over the basic lack of procedural fairness resulting from the majority's decision:

> Festo had not been informed that its evidence is limited to the prosecution record, upon which this court now decides the issue without Festo having had the opportunity to prove its case. At the trial, prosecution history estoppel was not at issue; SMC told the district court that "this is not really a prosecution history estoppel case." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 72 F.3d 857, 863 (Fed. Cir. 1995). Now that it is such a case, Festo is surely entitled to develop an evidentiary record. The court's refusal to remand on this ground of rebuttal, ruling that evidence outside the prosecution record is not admissible, renders this rebuttal criterion unlikely ever to be met.

(App. 41a-42a).

The dissent further notes the extreme difficulty patent holders will have rebutting the presumption based on the majority's decision which limits the evidentiary proofs that may be offered.

> The court limits the evidence of this criterion to the prosecution record. However, the factors relevant to determination of tangential relation are unlikely to reside in the prosecution record, for unrelated subject matter or unknown equivalents are unlikely to have been discussed by either the examiner or the applicant. The issue of "tangentialness" may require consideration of how the reason for an amendment affected the patentee's view that certain technology was extraneous. The prosecution record rarely discusses devices that are not prior art.

(App. 41a).

This is exactly the case at bar wherein no prior art rejection was made and the amendments at issue were made for clarification purposes and thus not discussed in detail in the prosecution record.

The majority's holding on the "some other reason" criterion was also unduly restrictive. Judge Newman stated:

> [t]he court imposes the requirement that the inventor was actually prevented from describing an unknown equivalent, in order to rebut the presumption of surrender -- and that the reason was contained in the prosecution history -- *a virtual impossibility*.

(App. 43a). (Emphasis added).

The important policy implications of this case were clearly identified in the dissent as follows:

> A national economic policy that weighs on the side of fostering development and investment in new technology will have a different approach to the law of equivalency than an economic policy aimed at facilitating competition by minor change in existing products. Any tightening or loosening of access to the doctrine of equivalents shifts the balance between inventor and copier. The high public interest in this case reflects these fundamentals, for the administration of this law affects major commercial and societal interests. The number and diversity of the amicus curiae[ ] briefs reflect the complexity of these concerns and the variety of viewpoints among technology- based enterprises. The public interest here is not in the fate of these litigants and these long-expired patents; the interest is in the way this judge made law affects technologic innovation and competition.

(App. 31a). (Footnote omitted).

REASONS FOR GRANTING THE WRIT

Petitioner seeks review because the judgment below (1) is in direct conflict with this Court's *Festo* decision and moves to reinstate the complete bar to equivalents; and (2) violates the Fifth Amendment right to due process of law.

The Federal Circuit has once again destroyed the delicate balance created by this Court between inventors and the public to the detriment of the patent system. The rebuttable *Festo* presumption was created by this Court to give patent holders the right to establish that an accused equivalent was not surrendered. However, this *Festo* presumption has been transformed into an irrebuttable presumption in a surreptitious attempt to resurrect the complete bar rule. The present decision of the Federal Circuit treats this Court's criteria for overcoming the *Festo* presumption as merely narrow exceptions to the unanimously rejected complete bar rule. The Federal Circuit has improperly restricted each one of the categories available for overcoming the new presumption by misinterpreting this Court's decision and severely limiting the scope of evidence that can be presented. The decision of the court below encourages "unscrupulous copyists"[4] to make insubstantial changes to avoid valid patent rights. The impact of this decision extends well beyond the facts of the present case. As Judge Newman recognized, "[The Federal Circuit's] application of the Court's decision in *Festo* places new and costly burdens on inventors, and reduces the incentive value of patents." (App. 43a). Since the Federal Circuit has exclusive jurisdiction of patent appeals from district courts, there can be no circuit conflict. Nor is it possible for the

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[4] The doctrine of equivalents was judicially created in order to preserve the value of patents as against imitators, described in *Graver Tank* as the "unscrupulous copyist." *Graver Tank*, 339 U.S. at 607.

issues presented here to be ventilated in other circuits. Accordingly, such a clear disruption of this Court's precedent mandates immediate review.

In its desire to institute a complete bar in clear contradiction to this Court's specific rejection of such doctrine, the Federal Circuit runs roughshod over patent holders' constitutional right of due process of law. The new rigid rules unfairly deny Festo the opportunity to demonstrate that it is still entitled to the protection of its invention after substantial changes in the application of the law and fifteen (15) years of intensive and costly effort in the judicial system. The manifest unfairness that results from the decision below necessitates review by this Court.

I. Certiorari Should Be Granted Because The Decision Below Resurrects The Complete Bar Contrary to The Decisions of This Court

This Court unanimously rejected a complete bar to the doctrine of equivalents for narrowing amendments made for patentability and vacated the Federal Circuit's *en banc* decision. "[T]here is no more reason for holding the patentee to the literal terms of an amended claim than there is for abolishing the doctrine of equivalents altogether and holding every patentee to the literal terms of the patent." (App. 56a). This Court recognized that a "narrowing amendment may demonstrate what the claim is not; but it may still fail to capture precisely what the claim is." *Id.* Therefore, in some cases an amendment "cannot reasonably be viewed as surrendering a particular equivalent." (App. 59a). Certain narrowing amendments do not surrender equivalents. "There is no reason why a narrowing amendment should be deemed to relinquish equivalents unforeseeable at the time of the amendment and beyond a fair interpretation of what was surrendered. Nor is there any call to foreclose claims of equivalence for aspects of the

invention that have only a peripheral relation to the reason the amendment was submitted." (App. 56a).

In order to balance the rights of inventors against those of the public, this Court instituted a presumption that a narrowing claim amendment surrenders all equivalents. However, this presumption is rebuttable, and this Court identified certain circumstances under which a patentee could overcome the presumption of surrender. (App. 58a-59a). Under the Federal Circuit decision, patentees including Festo are unduly restricted from fully and fairly rebutting the presumption before a court of first instance as mandated by this Court. Accordingly, the presumption becomes a substitute for the complete bar, or simply a "complete bar by another name," a policy expressly prohibited by this Court. (App. 59a).[5]

A. The Tangentialness Criterion Has Been Negated By This Court

One of the criterion specifically raised by this Court for rebutting the *Festo* presumption is whether the rationale underlying the amendment bears no more than a tangential relation to the equivalent in question. (App. 56a, 59a). However, the decision below effectively eliminates tangentialness as a possible basis for overcoming the

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[5] The Federal Circuit's drive to enact a complete bar is evidenced in its decisions beyond this case. In all the Federal Circuit decisions subsequent to this Court's decision in *Festo*, not one decision has found that the *Festo* presumption had been overcome. *See, e.g., Talbert Fuel Systems Patents Co., v. Unocal Corp.*, 347 F.3d 1355, 1359-60 (Fed. Cir. 2003); *Okor v. Atari Games Corp.*, 76 Fed. Appx. 327, 332-333 (Fed. Cir. 2003); *Pioneer Magnetics, Inc. v. Micro Linear Corp.*, 330 F.3d 1352, 1357 (Fed. Cir. 2003). Additionally, the Federal Circuit has decided that the *Festo* presumption is not applicable to claim elements whose scope may be affected by arguments during prosecution. For such elements a complete bar is established. *AccuScan, Inc. v. Xerox Corp.*, 76 Fed. Appx. 290, 291 (Fed. Cir. 2003) (Petition for Writ of Certiorari filed, Sup. Ct. Docket No. 03-869).

presumption for all patentees. The Federal Circuit interprets this category so narrowly that not even one example of its successful use can be formulated. (App. 12a). The attempt to limit or eliminate this category for overcoming the presumption is evidenced by the Federal Circuit erroneously referring to this category as "mere tangentialness" or "merely tangential". (App. 13a). Nowhere in this Court's *Festo* decision is the additional limitation "merely" used.

The Federal Circuit limits the evidence for establishing tangentialness to the prosecution history record. (App. 13a). Such an evidentiary restriction on the *Festo* presumption in effect tends to create a complete bar. For example, an unexplained or voluntary amendment by its very nature will not be discussed in the prosecution history. "The issue of 'tangentialness' may require consideration of how the reason for an amendment affected the patentee's view that certain technology was extraneous. The prosecution record rarely discusses devices that are not prior art." (App.41a). Accordingly, limiting the evidence to overcome the presumption in such circumstances to the prosecution history renders the presumption irrebuttable and further disrupts the balance struck by this Court in favor of the accused infringer.

As Judge Newman recognized, "[t]he court's refusal to remand on this ground of rebuttal, ruling that evidence outside the prosecution record is not admissible, *renders this rebuttal criterion unlikely ever to be met.*" (App. 42a). (Emphasis added.) For patents prosecuted before these new rules were enacted by the courts, like the patents of the present case, restriction to the file history is fundamentally unjust. The injustice imposed upon Festo is manifest. Festo has been denied its day in court to present evidence on this issue and protect its invention.

The restriction to the rebuttal evidence is contrary to this Court's precedent. In *Warner-Jenkinson*, this Court

created a rebuttable presumption with regard to unexplained amendments. *Warner-Jenkinson,* 520 U.S. at 33. A review of the prosecution history did not reveal a reason for the addition of a limitation, and therefore, the case was remanded. *Id.* at 34. Clearly, the development of additional evidence to explain the amendment was contemplated by this Court; otherwise remand would have been meaningless. Similarly in the present case, the limitation of the evidence to the prosecution history record is unwarranted and would frustrate the very purpose of the remand by this Court.

The holding by the Federal Circuit that "an amendment made to avoid prior art that contains the equivalent in question is not tangential" (App. 12a) is wrong and improperly broadens the territory of surrender. When a claim is amended to define over prior art by adding additional features, it is entirely possible that some of those features may be tangential to the reason the amendment was made. For example, if the cited prior art includes both the equivalent and the actual amended element, then the inclusion of the particular amended element did not define the invention over the prior art and may be tangential to the reason for adding the amendment. The Federal Circuit's interpretation leaves no room for this scenario. This Court's precedent requires a less wooden approach and an examination of the particular facts of the case.

The interpretation consistent with this Court's opinion and which gives the tangential category meaning is to look at the reason for making the amendment, *e.g.*, prior art, and then determine whether the element at issue was either directly related to overcoming the prior art or tangential to that reason. It is only through such case-by-case analysis that one can determine "aspects of the invention that have only a peripheral relation to the reason the amendment was submitted" and establish that no surrender has occurred. (App. 56a).

With regard to the Stoll patent in the present case, the Federal Circuit found that no reason for adding the magnetizable material was evident from the prosecution history. (App. 16a-17a). Therefore, the court concluded that the tangential criterion could not be met. (App. 17a). The reason for including such a limitation was not at issue either during the patent prosecution or the trial. On remand from this Court in view of *Warner-Jenkinson*, the Federal Circuit failed to remand this case to the district court to permit Festo to develop a record which clearly set forth the reason for the amendment.[6] However, Festo has proffered that the reason for the amendment in the Stoll application was to overcome a rejection based on §112 in which the examiner inquired as to the nature of the invention. In response to the rejection, the claims were rewritten to clarify the nature of the invention.[7] The material of the sleeve had nothing to do with overcoming this rejection nor does the equivalent, aluminum alloy sleeve, have any relationship whatsoever to the reason for making the amendment. The Federal Circuit, without the benefit of any record below on this matter, found that there was no reason for the amendment and the presumption could not be rebutted. This is clear error resulting from the deciding of a factual issue in the first instance on appeal when the record below did not address this issue.

The other claim limitation at issue in this case is the recitation of two sealing rings. Despite there being no prior art rejection along with the fact that the use of two sealing

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[6] The Federal Circuit examined only the file history to determine the reason for the amendment. Since the *Warner-Jenkinson* presumption only arose when an amendment was unexplained, the limitation of the evidence to rebut this presumption made it an "irrebuttable fiat." (App. 198a-199a).

[7] Contrary to the majority's statements, the claims of the Stoll patent were never amended; the original sole independent claim was cancelled and a new independent claim presented. (App. 35a).

rings was disclosed in the prior art, the Federal Circuit found that these elements were added for prior art reasons. (App. 19a). The court below makes this conclusion based on an erroneous reading of the file history, a record not directly addressing this newly created issue, and on limited briefing[8]. During the trial phase, SMC never asserted that the sealing rings were made for prior art reasons even though the law at the time would have found prosecution history estoppel when claim elements were added to overcome prior art. *See* (App. 41a), *Warner-Jenkinson*, 520 U.S. at 31. The error of the court below was precipitated by the appellate court deciding factual issues of first impression on appeal.

B. "Some Other Reason" Has Been Improperly Restricted

The Federal Circuit misconstrues this Court's "some other reason" category for overcoming the *Festo* presumption. This Court recognized that there are cases where an "amendment cannot reasonably be viewed as surrendering a particular equivalent." (App. 59a). While specifically listing two situations where there is no surrender, the Court also recognized that there may be others. *Id.* Far from creating a narrow list of exceptions to the presumption of surrender, this Court provided other possible bases for overcoming the presumption. This Court clearly intended to make sure that inventors' rights should not be unduly restricted in view of other available reasons that might not yet be apparent. The "some other reason" category was not

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[8] The court decision finding that the sealing rings were made for prior art reasons was the result of briefing limited to five questions posed by the court. None of those questions asked why the amendments were made. (App. 62a-63a). Additionally, in its original *en banc* decision, any amendment made for any reason to comply with the patent act created an absolute bar. (App. 69a, 73a). Accordingly, the actual reason for the amendment was not pertinent to the decision and therefore, not carefully considered.

characterized as being narrow or in some way limited. Accordingly, to the extent that evidence is relevant in overcoming the presumption, a patentee should be afforded the opportunity to offer any such evidence.

In contrast, the court below inexplicably found this Court's "some other reason" category as "vague" and that it "must be a narrow one." (App. 13a). This interpretation is inconsistent with this Court's holding. As Judge Newman recognized, the majority's decision on the "some other reason" criterion "imposes the requirement that the inventor was actually prevented from describing an unknown equivalent, in order to rebut the presumption of surrender -- and that the reason was contained in the prosecution history -- a virtual impossibility." (App. 43a). However, this Court more broadly stated this category as a reason "suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question." (App. 59a). The ability to overcome the presumption is limited by the Federal Circuit, which in all practical effect resurrects its rejected complete bar. The Federal Circuit's erroneous interpretation further disturbs the balance created by this Court in favor of the infringer who has done nothing but made insubstantial changes to avoid literal infringement.

The scope of surrender may be effected by various factors which fall within the some other reason category. For example, in the present case, the elements at issue in the Stoll patent for which equivalents were found were originally presented in dependent claims. (App. 37a). The original independent claim was cancelled and a new independent claim presented. The inclusion of these elements in dependent claims which were originally filed bears on the scope of surrender. Festo should have an opportunity to develop evidence in this area to establish that the scope of surrender did not include the accused equivalent elements.

In the present case, based solely on the prosecution and trial records developed years before these new rules were put in place, the Federal Circuit improperly found that Festo could not overcome the presumption under the some other reason category. This is clear error.

C. The Foreseeability Criterion Has Been Erroneously Interpreted

The Federal Circuit ruled that known equivalents cannot be unforeseeable. "[I]f the alleged equivalent were known in the prior art in the field of the invention, it certainly should have been foreseeable at the time of the amendment." (App. 12a). If the amended element is narrowed to avoid a particular element of the prior art, it is true that such particular prior art element would be foreseeable. However, to state more broadly that simply because a particular element exists somewhere in the prior art automatically renders it foreseeable is improper. Such an interpretation narrows the foreseeability criterion to a point well beyond the holding of this Court. Patent holders must be permitted to present evidence on this criterion unencumbered by the Federal Circuit's overly restrictive holdings.

II. Certiorari Should Be Granted Because The Federal Circuit Decision Violates The Due Process Clause Of The Constitution

The Fifth Amendment to the Constitution guarantees due process of law. U.S. Const. Fifth Amend. "The essential guarantee of the due process clause is that of fairness." 3 R. Rotunda & J. Nowak, Treatise on Constitutional Law §17.8, p. 100 (3d. ed. 1999). As recognized by Judge Newman and Chief Judge Mayer, the Federal Circuit's decision works tremendous unfairness to Festo and those similarly situated

by preventing a complete record to be developed on the underlying facts pertinent to overcoming the presumption.

> All three classes of rebuttal raise questions of fact and all raise questions of first impression, requiring full and fair exploration of the issues with benefit of the procedures of trial. The court's limitation of the presentation of evidence that may serve to rebut the presumption of surrender *constricts judicial ability to render a just decision.*

(App. 43a) (Emphasis added).

The basic right to have the opportunity to come forward with evidence and present that evidence to a decision maker has been unjustly denied. The addition of a new rebuttable presumption, long after the record in this case was closed, requires that this case be sent to the district court for the development of new evidence. This result was advocated by the United States in its A*micus Curiae* brief to this Court. Brief for the United States as *Amicus Curiae* Supporting Vacatur and Remand, 2001 WL 1025650 at 28 (U.S. August 2001). Despite the warnings expressed in *Warner-Jenkinson* and *Festo* for implementing changes in the law, the Federal Circuit exercises wreckless disregard in making rulings against Festo regarding the new presumption and disposes of issues without the safeguards of a trial. The *Festo* presumption has been made irrebuttable for all practical purposes through the denial of the right to present evidence and the misinterpretation of this Court's decision. Such action denies patent holders of the Fifth Amendment's guarantee of due process.

A. Patent Holders Are Entitled To Procedural Due Process Regarding The *Festo* Presumption

The Due Process clause of the Fifth Amendment of the Constitution has been found to include a right to a fair

decision-making process when one's life, liberty, or property is to be harmed by actions of the Federal government. 2 Rotunda & Nowak, *supra* at §14.6. Actions by the judiciary must comply with the due process requirements. *Nelson v. Adams USA, Inc.*, 529 U.S. 460, 471 (2000) (The Federal Circuit reversed on due process grounds). Basic to the right to due process is the requirement that a party be given notice and a fair opportunity to present evidence when underlying facts are in dispute. *Jenkins v. McKeithen*, 395 U.S. 411, 429 (1969). This Court has further determined that presumptions which are in effect irrebuttable violate due process. *Cleveland Board of Ed. v. LeFleur*, 414 U.S. 632, 644 (1974), *U.S. Dep't of Agriculture v. Murry*, 413 U.S. 508, 514 (1973). Additionally, where the right to appeal is granted by statute, the improper denial of that right raises to a violation of due process. *Evitts v. Lucey*, 469 U.S. 387, 393 (1985).

A patent is a property right. 35 U.S.C. §261 ("Subject to the provisions in this title, patents shall have the attributes of personal property."), *Union Paper-Bag Machine Co. v. Murphy*, 97 U.S. 120, 121 (1877). The claims define the scope of that right. *A.B. Dick Co. v. Burroughs Corp.*, 713 F.2d 700, 702 (Fed. Cir. 1983). A patent bestows upon its owner the right to exclude others from making, using, selling, or importing the patented invention. 35 U.S.C. §271(a). The patented invention is defined by the claims, and devices falling within the scope of the claims are those which include every element of the claim or its equivalent. *See Graver Tank*, 339 U.S. at 607. Whether a particular equivalent has been surrendered by amendment and, therefore, not within the scope of the patent grant is the essence of the *Festo* presumption. Accordingly, the determination of whether the presumption can be overcome, and infringement successfully asserted, clearly affects a property right. In the present case, the Federal Circuit has effectively rendered the presumption irrebutable, and Festo's

property right has been vitiated, without the procedural due process guaranteed under the Fifth Amendment.

B. The Federal Circuit's Decision Denies Patent Holders The Right To Present Evidence

"The right to present evidence is, of course, essential to the fair hearing required by the Due Process Clause." *Jenkins*, 395 U.S. at 429. Festo has not been given a fair opportunity to develop and present evidence to overcome this Court's newly created presumption. Since the close of the record in this case, fundamental changes have occurred to the doctrine of equivalents. When this case was being prosecuted and was before the trial court, only amendments motivated by the prior art created prosecution history estoppel. Now, any amendment made to comply with the requirement of the patent law have been found to create prosecution history estoppel. (App. 69a, 73a). At the time of trial, the patent holder was not faced with the burden of overcoming a presumption that the amendment of a claim element surrendered all equivalents of that element. Under the accepted law during the time of trial, the issues of prosecution history estoppel did not prevent a finding of infringement. (App. 258a-276a). At trial, the defendant SMC declared to the district court that "this was not really a prosecution history estoppel case." (App. 41a). The record developed during the trial was in no way adequate to address the changes in the law now governing this case. To limit Festo to such a record is unconscionable.

In spite of this sea change in the law occurring after the creation of the record below, the Federal Circuit has used an incomplete and inadequate record to severely limit Festo's right to rebut the *Festo* presumption. Two of the three categories of exceptions to the presumption of surrender enumerated by this Court have been found not to apply. As to foreseeability, the issue was remanded to the

district court; however, the Federal Circuit prejudged the issue and put its "thumb on the scale." *See* (App. 39a). These findings were done by the Appellate Court without providing any opportunity for Festo to develop and present new evidence relevant to overcoming the presumption. Therefore, Festo is prohibited on remand from presenting evidence that the amendment was tangential or that some other reason exists to overcome the presumption of surrender. This is clearly at odds with the spirit of this Court's decision vacating the Federal Circuit's complete bar ruling and remanding for further findings in the first instance regarding the new issues raised.

Furthermore, by limiting the universe of possible evidence to the file history, the Federal Circuit effectively insured that tangentialness criterion could not be successfully employed to overcome the presumption. As recognized by Judge Newman, "factors relevant to determination of tangential relation are unlikely to reside in the prosecution record." (App. 41a). This is especially true when the file history was created before the establishment of the *Festo* presumption at a time when patent applicants had no reason to provide the detailed level of explanation now required.[9] Despite the Federal Circuit's recognition that expert testimony may be necessary to interpret the file history, Festo has been denied even this opportunity. (App. 13a). The patents at issue were prosecuted well before the creation of a presumption of a surrender and to hold Festo to evidence strictly located in the file history is grossly unfair. Moreover, the Federal Circuit's reason for such a limitation, providing certainty in determining when estoppel applies, has been subordinated by this Court to the legitimate

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[9] The Federal Circuit has created a double-standard with respect to the evidence to be considered when looking at the *Festo* presumption. New cases at the district court level will most likely include evidence that can be used to overcome the *Festo* presumption.

expectations of inventors and their property. (App. 57a). Providing reasons for amendments, especially for those which are peripheral to the reason for the amendment, was clearly not expected of patentees prior to this Court's Festo ruling.

The Federal Circuit has in effect issued an order *in limine* for all future cases without a motion being made of the particulars considered. Fed. R. Evid. 402 states that "[a]ll relevant evidence is admissible, except as otherwise provided by the Constitution of the United States, by Act of Congress, by these rules, or by other rules prescribed by the Supreme Court pursuant to statutory authority." The courts have recognized that "[t]he Federal Rules of Evidence are statutes, and district judges may not disregard statutes no matter how inconvenient or cumbersome they believe the rules to be." *In re Oil Spill by the Amoco Cadiz*, 954 F.2d 1279, 1305 (7th Cir. 1992). The Federal Circuit decision, based on public notice and not on relevancy, ignores this basic rule and improperly limits relevant evidence. What evidence is relevant to overcoming the presumption should be left to the Federal Rules of Evidence and the sound discretion of the district court and only reviewed by an appellate court if the issue is properly presented on appeal.

In addition, the need to remand this case to the district court to permit the evidentiary record to be reopened was advanced by the United States as *amicus curiae*. It was the United States relying on this Court's opinion in *Warner-Jenkinson*, which, advocated the creation of a rebuttable presumption of surrender, a position subsequently adopted by this Court. (App. 58a). Recognizing that such a presumption added a new burden on patent holders such as Festo, the United States asked for this Court to remand the case to the district court. Brief for the United States as *Amicus Curiae* Supporting Vacatur and Remand, 2001 WL 1025650 at 28. ("Because the patent law landscape has

changed considerably since the district court initially entered its judgment in 1994, and because further assessment of the facts may be necessary, the court of appeals should remand the case to the district court for reconsideration in the first instance.")

Furthermore, in *Warner-Jenkinson*, this Court counseled caution when applying a new presumption so as not to work an injustice against patent holders. "The new presumption, if applied woodenly, might in some instances unfairly discount the expectations of a patentee who had no notice at the time of patent prosecution that such a presumption would apply." *Warner-Jenkinson* 520 U.S. at 41. (Ginsburg, J., joined by Kennedy, J., concurring). The Federal Circuit has once again failed to heed such warning and has constructed an unnavigable labyrinth for patentees to contend with in order to rebut the presumption. This is especially true for the multitude of patent holders, such as Festo, where the prosecution and trial took place before the new rules.

C. The Irrebuttable Nature Of The *Festo* Presumption Violates Procedural Due Process

This Court has found that the creation of a presumption which cannot be overcome conflicts with the principles of due process. *Cleveland Board of Ed.,* 414 U.S. at 644; *Murry*, 413 U.S. at 514. As set forth in Section I *supra*, the Federal Circuit seeks to reinstate its complete bar, thereby transforming the rebuttable *Festo* presumption into an irrebuttable certainty. The Federal Circuit's decision further frustrates the procedural fairness by such action. The court below has not only limited the interpretation of the foreseeability, tangentialness, and some other reason categories, but it has also severely limited the evidence that can be applied. If a patentee made a narrowing amendment,

especially in the "absence of clear rules of the game,"[10] the ability to overcome the presumption is severely impaired.

D. The Federal Circuit Decision Deviates From Accepted Procedure By Deciding Facts At The Appellate Level

Further contributing to the violation of Festo's due process rights is the Federal Circuit's deviation from the accepted procedures governing the allocation of responsibilities between the district court and appellate courts. *See* 3 Rotunda & Nowak, *supra* at §17.1 The proper and accepted role of the appellate court has been clearly delineated by this Court. *See Icicle Seafoods, Inc. v. Worthington*, 475 U.S. 709, 714 (1986) ("findings of fact essential to a proper resolution of the legal question . . . should have [been] remanded to the District Court to make those findings"; *Pullman-Standard v. Swint*, 456 U.S. 273, 291-92 (1982) ("[F]actfinding is the basic responsibility of district courts, rather than appellate courts, and . . . the Court of Appeals should not have resolved in the first instance this factual dispute which had not been considered by the District Court.") (quoting *De Marco v. United States*, 415 U.S. 449, 450 (1974)). (All alterations in original.)

The Federal Circuit decided in the first instance the issues relating to whether Festo could overcome the presumption, despite those issues being based on factual determinations. The court declared that the question of whether a patentee can overcome the *Festo* presumption is one of law; however, the conclusion is clearly based on factual underpinnings. With regard to the tangential criterion, why an amendment was made and how it related to the equivalent in question are factual questions. For example, the nature of the prosecution action, the content of

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[10] *See Warner-Jenkinson*, 520 U.S. at 42.

any references that led to the narrowing amendment, and the differences between the claimed subject matter and the alleged equivalent are factual questions to be decided with the safeguards of trial, not in an appellate court.

Basic fairness dictates that Festo must be given an opportunity to develop the record in the district court to have a full opportunity to rebut the newly created presumption. At the trial level, SMC conceded that "this is not really a prosecution history estoppel case" and no record was required to be developed on this issue. (App. 41a). The decision below should be vacated, and this case should be remanded to the district court to permit Festo to develop a record to rebut the presumption using all avenues provided by this Court, unfettered by unnecessary and stifling evidentiary restrictions. Deference should be accorded to the district court's role in developing the record and the Federal Circuit should perform its accepted task of judicial review only after the issues for appeal are clearly delineated. In this manner, the rights of all parties can be fully protected and fairly adjudicated.

III. Certiorari Should Be Granted Since The Decision Below Affects A Vital Area Of The Patent Law

The decision below disrupts a very important area of the patent law. The doctrine of equivalents was created to prevent patented inventions from being duplicated through the use of minor insubstantial changes. When the ability to prevent such duplication is lost, the value of the patent system is severely undermined. "Any tightening or loosening of access to the doctrine of equivalents shifts the balance between inventor and copier." (App. 31). The shift in the balance toward the copier resulting from the Federal Circuit decision requires this Court's immediate action.

The significance of this issue is evidenced by this Court's recent decisions addressing this subject. (App. 44a-

60a), *Warner-Jenkinson*, 520 U.S. at 21. Furthermore, the high public interest in this case has prompted numerous parties, including those representing educational institutions, industry, and the legal field, to file *amici curiae* briefs in both this Court and the court below. *See* U.S. Sup. Ct. *Festo* Docket No. 00-1543, (App. 31a). The United States has recognized the importance of this area of the law and has participated in this case as *amicus curiae* before both this Court and the Federal Circuit. (App. 10a, 58a). The importance of the issues presented in this case necessitate that this Court again reset the balance between inventor and copier.

CONCLUSION

For the reasons set forth above, this petition should be granted.

Respectfully submitted,

CHARLES R. HOFFMANN
Counsel of Record
GLENN T. HENNEBERGER
ANTHONY E. BENNETT
HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(516) 822-3550